REMARKS

In the Office Action of 16 May 2004, the Examiner withdraws his objections over Patent 6,258,200 issued to Kassab, over Patent 5,403,025 issued to Shanley and over Patent 5,334,431 issued to Longtin

However, as stated in item 7, the Examiner rejects claims 24-29 and 330-40 under 35 USC 102(b) as being anticipated by Su.

The Examiner also rejects claims 1-10, 13-17, 19, 24-29 and 31-41 under 35 USC 103 (a) as being unpatentable over Su(Patent 5,462,782)

The Examiner further rejects claims 11-12,18 and 30 under USC 102 (b) as being unpatentable over Su in view of GB 1.005,155

The applicant thanks the examiner for withdrawing his objections based on the Kassab, Shanley and Longtin references.

The applicant respectfully disagrees with the Examiner's rejection of :

- (Item 7, page 3) claims 24-29 and 33-40 under USC 102(b) as anticipated by Su
- (Item 9, page 4) claims 1-1, 13-17, 19, 24-29 and 31-41 due to Su (5,462,782) and
- (Item 10, page 5)claims 11-12, 18 and 30 due to Su in view of GB 1,005,155

and believes these are in condition for allowance for the reasons discussed below.

Item 7. **Rejection of Claims 24-29 and 33-40**

under 35 USC 102 (b) as being anticipated by Su.

The applicant recalls the fundamental differences between Su and the present application with regard to the structure, scope and intention of these different inventions.

Both inventors base their ideas on the known "cling" properties of suitably softened PVC, on the use of adhesives and associated protective layers. But the similarities stop there. With respect, the applicant does not believe that the mere common use of well-known cling and adhesive properties constitutes any awareness in Su of the solution offered by

the applicant. The solutions are only weakly similar in that they mount, for display, in some way, sheet objects.

Su teaches a three-layered structure, based around a hard (stiff) plastic layer, which is intended to act as a "plate assembly to which a sheet object, such as a propaganda, advertisement or photograph can be adhered".

Please refer to Fig 1 attached and to Su's Fig 1
Su therefore creates a stiff, flat plate, which is designed to flatten the sheet adhered to it. Importantly, he teaches *adhering the sheet to the plate* and does not teach of a tool, as the present application claims, which is adhered to sheet material much larger than itself.

That is, in Su, the sheet object to be displayed is generally the same size as, or smaller than, the invented plate assembly, whereas the present application creates small label-like tools to affix to a sheet many times their size. Nor is the difference simply a matter of degree or of claimed size; Su's flat plate assembly MUST be at least as large as the sheet it fixes, whereas the present mount should be as small as practicable, to be affixed to a fraction of the face of its sheet.

In any case were Su's item to be produced at a small size, (thus immediately foregoing the first-stated objective of that invention – to flatten the sheet object by adhering it on to the hard flat component) and were such a small example of Su's invention to be attached to larger-than-itself sheet objects for the purpose of adhering said sheet object to a glazy surface, then the present application, 09/905,261 should, the applicant contends, be regarded as a significant improvement, since it does the job with fewer components, is easier to make and, importantly, reveals thinking that Su does not: ie that, for practical purposes, the glazy surface will, in any case serve to flatten the sheet object.
The hard sheet of Su's so-called "assembly" would be redundant in a smaller-than-sheet-object size; that is to say, the present invention is different, invented to solve a different problem a different way and a significant improvement over Su where there are similarities.

Claims 24 –29 relate, it is submitted, to the intrinsic difference in the intentions of the two inventors as to the tasks to be undertaken. Su has thus no call over claims 24 and 25 in particular due to the complexity of his laminate invention.

With regard to the further reasons, given in the Examiner's item 7, for rejection of these items, the applicant would respectfully point out that it is the present application and not Su, which makes and can make the claims cited therein.
That is, nowhere does Su refer to "a mount", but uses the term "an assembly". It is an assembly *upon which* may be mounted sheet objects.

Nor does Su refer to "...capable of adhering the mount only to a part of one surface of a sheet". Su never claims, as is said in item 7, that the entire surface of the mount is adhered to less than half the surface of the sheet. As said, his invention absolutely would not work in its first intention were this to be the way it was employed.

This is part of the essential differences mentioned earlier and is a valid reason, the applicant submits, for the inclusion, in the present application, of the differentiating claims which draw their dependencies from claim 1 and refer, for example, to the invention being "capable of adhering the mount only to a part of a surface of a sheet..". As shown in Fig 2, attached, Su's invention must be at least as big as the sheet object for it to achieve his first stated intention – to flatten the sheet on to the assembly.
With reference to the Examiner's view of the phrase "capable of", the applicant submits that the expression, (which should properly be taken as "..capable of adhering the mount *only* to a part...") is in fact, as intended, a limiting statement with regard to the size of the mount in relation to the sheet to which it is being adhered.

Although it is a configuration of the present invention to mount the sheet object so that it may be viewed directly, being attached to the glazy surface by the mounts on its "back", most usually it will be attached to the "face" of the sheet object to permit viewing the sheet object *through* the glazy surface and in this configuration it is an improvement over Su's assembly which is larger than the sheet object, so that the sheet has to be viewed through two layers of plastic sheet and two layers of adhesive.

Item 9 **Rejection of claims1-10, 13-7, 19, 24-29 and 31-41**
under 35 USC 103 (a) as being unpatentable over Su

The applicant respectfully disagrees with the Examiner's rejection of **claims 1-10**.

In Patent 5,462,782, Su creates the "cling" properties of his plate assembly by adhering soft PVC to the hard plate as *an additional layer*. In the present application, the soft "cling" PVC, with adhesive on one side, is *the entire structure*. The Su flat plate seeks to use the first, hard plate to flatten the sheet, whereas in the present invention, the glass window or other glazy surface against which the sheet is hung, does the flattening, as discussed above.

In the present application, all claims relate to a single soft plastic material plus its protective layer. Never to any assembly. The intentions of the two inventions, the applicant submits, are different.

Reference has been made by the Examiner to the supposition that Su would have understood how to *create* a plurality of mounts. The applicant readily agrees this manufacturing skill can be assumed but would submit that, whereas the present invention is *intended* to be supplied and used as a plurality to attach a sheet object larger than itself, Su's plate is the same size as, or larger than the sheet and he would envisage only one being used per sheet. We may not, the applicant contends, assume the further invention, or improvement, by Su to provide a small, single sheet items such as is the subject of the present invention. The applicant indeed initially developed a tool which would be the same size as the sheet object but quickly saw the improvement to the smaller item because the larger the soft PVC surface, the poorer the cosmetic appearance of the interface with the glazy surface.

Had Su arrived at the idea of using small multiple cling mount assemblies of the sizes instanced in the present application, to hang paper on glass by its corners instead of sticking sheets on a flat display panel, he would surely have recognised it as a different technique, a different product and sought to patent it as a separate invention. The applicant agrees that, had Su thought of the idea, he *would have been able to make* smaller mounts. They would have been very unlikely to comprise the materials his patented "plate assembly" does. But he didn't think of it. The present applicant did – and that is, it is contended, the basis for allowing the present application.

Addressing Item 9, paragraph 3 on page 4, it is accepted that it is not unusual for a product like the Mount referred to in the present application to be produced on rolls. The reference to presentation on a roll is a dependency of the main claim and defines how these particular mounts may be provided. (Su would be unable to provide his invention on a roll, as a major feature of his assembly is that it is based on a hard plate.)

The applicant believes that the above arguments also answer the Examiner's comments in item 9., paragraph 4 on page 4 concerning the thickness and size claims in the present application. It has been shown that the difference in size between the present invention and Su is important and reflects the different intentions of the inventors.

Item 10 **Rejection of claims 13-17, 19, 24-29, 31-41**

Claims 13-17 are patentable over Su, it is contended, as:

- Claim 13 relates to the entire structure of the invented tool, described in claims 1 and 10, being of PVC. Su's plate comprises, as noted, of a duplex laminated structure, stuck together with an additional adhesive film. (Fig 1, attached)
- Claim s 14-17 are allowed, it is submitted, as they refer to the two issues, discussed above, of the sizes and the plurality of the two inventions. That is, Su does not refer to, or claim any dimensions for his plate but refers to sheets being adhered to it and so the preferred dimensions instanced in the present application would be out-with the scope and spirit of his invention. Su's product will not work as per its patented claims if the assembly is smaller than the sheet.

Claims 19, 24-29 and 31-41 are patentable over Su in the view of the applicant, because there has been established a sufficiently large amount of evidence that, outside of the use of similar raw materials, there is no similarity between the two inventions in structure or intention or method, while in addition, these above claims have been established as not standing alone and claiming any rights over the mentioned well-known aspects such as plasticisers technology (or preferred sizes) but merely cited as dependencies of the main cliams referred to.

Item 10 **Rejection of Claims 11-12, 18 and 30**
as unpatentable over Su in view of GB 1.005.155

It is readily agreed by the applicant that the composition and properties of PVC softened with plasticisers are well-known and assumed - by both Su and MacAlister.

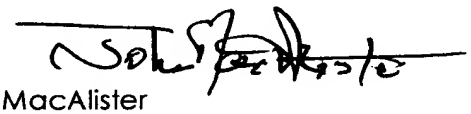
The above claims in the present application do not seek to claim any of the prior art in this context. Rather, these claims – and others - are patentable by virtue of their dependencies from claim 1 and refer to the main claim, simply further defining, as they do, the invention in some way as to its material, preferred sizes, gauge etc.

Conclusion

The applicant respectfully asks that the examiner withdraw his remaining objections to the patentability of the present application over Su.

Should the examiner feel that a phone interview would be helpful, he is respectfully requested to contact the applicant, John MacAlister, on +44 1728 668 204, at any time, notwithstanding the time-zone differences.

Submitted by



John MacAlister
November 12th, 2004